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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,554	03/08/2002	Yasutaka Ishii	3273-0153P	1456
2292	7590	02/16/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			SHIAO, REI TSANG	
PO BOX 747			ART UNIT	PAPER NUMBER
FALLS CHURCH, VA 22040-0747			1626	

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	10/092,554	ISHII ET AL.	
	Examiner	Art Unit	
	Robert Shiao	1626	
--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --			
<p>THE REPLY FILED on 10 January 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may <u>only</u> be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.</p>			
PERIOD FOR REPLY [check either a) or b)]			
<p>a) <input checked="" type="checkbox"/> The period for reply expires <u>3</u> months from the mailing date of the final rejection.</p> <p>b) <input type="checkbox"/> The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.</p>			
<p>ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).</p>			
<p>Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</p>			
<p>1. <input type="checkbox"/> A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.</p>			
<p>2. <input checked="" type="checkbox"/> The proposed amendment(s) will not be entered because:</p>			
<p>(a) <input type="checkbox"/> they raise new issues that would require further consideration and/or search (see NOTE below);</p>			
<p>(b) <input type="checkbox"/> they raise the issue of new matter (see Note below);</p>			
<p>(c) <input checked="" type="checkbox"/> they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or</p>			
<p>(d) <input type="checkbox"/> they present additional claims without canceling a corresponding number of finally rejected claims.</p>			
<p>NOTE: ____.</p>			
<p>3. <input type="checkbox"/> Applicant's reply has overcome the following rejection(s): ____.</p>			
<p>4. <input type="checkbox"/> Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).</p>			
<p>5. <input type="checkbox"/> The a)<input type="checkbox"/> affidavit, b)<input type="checkbox"/> exhibit, or c)<input type="checkbox"/> request for reconsideration has been considered but does NOT place the application in condition for allowance because: ____.</p>			
<p>6. <input type="checkbox"/> The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.</p>			
<p>7. <input type="checkbox"/> For purposes of Appeal, the proposed amendment(s) a)<input type="checkbox"/> will not be entered or b)<input type="checkbox"/> will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.</p>			
<p>The status of the claim(s) is (or will be) as follows:</p>			
<p>Claim(s) allowed: ____.</p>			
<p>Claim(s) objected to: ____.</p>			
<p>Claim(s) rejected: ____.</p>			
<p>Claim(s) withdrawn from consideration: ____.</p>			
<p>8. <input type="checkbox"/> The drawing correction filed on _____ is a)<input type="checkbox"/> approved or b)<input type="checkbox"/> disapproved by the Examiner.</p>			
<p>9. <input type="checkbox"/> Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). ____.</p>			
<p>10. <input checked="" type="checkbox"/> Other: <u>See Continuation Sheet</u></p>			

Responses to Amendment/Arguments

Applicant's arguments regarding the rejection of claims 3-4 under obviousness-type double patenting over Ishii et al. US 6,232,258 filed on January 10, 2005, have been fully considered but they are not persuasive. It is noted that the common inventor Yasutaka Ishii invented the invention of US 6,232,258 and the instant invention. The instant claims are drawn to a catalyst comprising a compound of formula (II), still renders obviousness-type double patenting over Ishii et al. US 6,232,258. Since claim 3 has been cancelled, therefore, rejection of claim 3 under obviousness-type double patenting is obviated.

Claims 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10, lines 1 and 4, recites the limitation "comprising" or "Rx is a hydrocarbon group having five or more carbon atoms" respectively, is ambiguous and indefinite. The instant claim recites the limitation "comprising", which is an open-end language and comprise products other than the compound of formula (II), i.e., acid or strong acid, see pages 17-21, and examples on pages 113-120. The instant claim also recites the limitation "or more carbon atoms", which is an open-end language without limitation of variable Rx, i.e., having 21 carbon atoms, see examples on pages 113-120. Replacement of the limitation "comprising" with the limitation "consisting of", would obviate the rejection, see pages 17-21, and examples on pages 113-120. Moreover, replacement of the limitation "or more carbon atoms" with the limitation "from five to twenty carbon atoms", would obviate the rejection, see pages 17-21, and examples on pages 113-120.

2/14/05 R.D.
R. Desai
2/14/05